

parent of U.S. Application Serial No. 08/255,539 filed June 6, 1994 (now U.S. Patent 5,564,546) and cross-reference is further made to U.S. Application 09/178,441 for "Voucher Coding for Self-Service Coin Discriminator" filed on October 23, 1998 (now U.S. Patent 6,116,402) and to PCTG/US97/11174 filed June 27, 1997 for "Coin Discrimination Apparatus and Method," all of which are incorporated herein by reference.

### REMARKS

Claims 2-9, 15-19, and 21-24 are currently pending in this application. During prosecution of prior, related Patent application 09/422,917, the Examiner rejected these pending claims under 35 USC 103(a) over U.S. Patent number 6,116,402 to Beach et al. ("Beach").

Applicants would like to respectfully point out to the Examiner that the cited reference Beach has an effective filing date of October 23, 1998, as does the present application (see attached copy of Declaration filed on September 21, 2001, under 37 CFR § 1.63). Accordingly, Applicants submit that Beach is not available as a prior-art reference in regard to the present application and cannot serve as a basis for rejection of the pending claims.

Respectfully submitted,  
Perkins Coie LLP



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Enclosures:

Postcard  
PTO-1083  
Appendix  
Declaration Under 37 CFR § 1.63

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**APPENDIX – SPECIFICATION**

**MARKED TO SHOW CHANGES**

Paragraph beginning at Page 1, line 1:

This application is a continuation of U.S. Patent Application No. 09/422,917, filed October 21, 1999, and currently pending, which claims priority to U.S. Provisional Patent Application No. 60/105,508, filed October 23, 1998. Cross-reference is made to U.S. Patent Application 09/035,273, filed March 8, 1998 which is a continuing application claiming priority from Serial No. 08/237,486 filed May 3, 1994 (now U.S. Patent 5,620,079) which is a continuation-in-part of U.S. Patent application 07/940,931 filed September 4, 1992 which is the parent of U.S. Application Serial No. 08/255,539 filed June 6, 1994 (now U.S. Patent 5,564,546) and cross-reference is further made to U.S. Application 09/178,441 for "Voucher Coding for Self-Service Coin Discriminator" filed on October 23, 1998 (now U.S. Patent 6,116,402) and to PCTG/US97/11174 filed June 27, 1997 for "Coin Discrimination Apparatus and Method," all of which are incorporated herein by reference.

**RULE 63 (37 CFR § 1.63)**  
**DECLARATION**  
**FOR PATENT APPLICATION**  
**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name, and I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled COIN-DISCRIMINATOR VOUCHER ANTI-COUNTERFEITING METHOD AND APPARATUS, filed October 21, 1999 as assigned U.S. Patent Application Serial Number 09/422,917, further identified as Attorney File No. 3730-913.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above. I acknowledge the duty to disclose information which is material to patentability in accordance with 37 CFR 1.56(a) and (b) as set forth on the attached sheet indicated Page 3 hereof and which I have read.

I hereby claim foreign priority benefits under 35 U.S.C. 119/365 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

<u>Prior Foreign Application(s)</u>	<u>Priority Claimed</u>			
<u>Number</u>	<u>Country</u>	<u>Day/Month/Year Filed</u>	<u>Yes</u>	<u>No</u>

I hereby claim the benefit under 35 U.S.C. 120/365 of all United States and PCT international applications listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in such prior applications in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose information material to patentability in accordance with 37 CFR 1.56(a) and (b) which occurred between the filing date(s) of the prior application(s) and the national or PCT international filing date of this application:

<u>Application Serial No.</u>	<u>Filing Date</u>	<u>Status: patented, pending, abandoned</u>
60/105,508	October 23, 1998	pending

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

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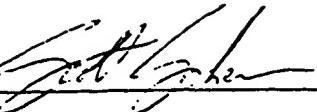
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37 CFR §1.56(a) and (b)  
DUTY TO DISCLOSE INFORMATION MATERIAL  
TO PATENTABILITY

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of a patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.\*

\*Note, 37 CFR §1.97(h) states: "The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in §1.56(b)."